

PRE-APPEAL BRIEF REQUEST FOR REVIEW**(filed with the Notice of Appeal)**Docket Number
042933/271450Application Number
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03/10/2004First Named Inventor
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2617Examiner
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Respectfully submitted,

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REMARKS/ARGUMENTS

These remarks are hereby filed concurrent with a Pre-Appeal Brief Request for Review. Initially, Applicant notes the Examiner's indication of withdrawal of the rejection of Claim 10 under 35 U.S.C. § 112, second paragraph, in the Examiner's Interview Summary of March 23, 2009. However, the Office continues to reject all of the pending claims, namely Claims 1-54, as being anticipated by U.S. Patent Application Publication No. 2002/0058504 to Stanforth, or as being unpatentable over Stanforth, in view of U.S. Patent Application Publication No. 2004/0024879 to Dingman et al. As explained below, however, Applicant respectfully submits that the claimed invention is patentably distinct from Stanforth and Dingman, taken individually or in any proper combination. In view of the remarks presented herein, Applicant respectfully requests reconsideration and withdrawal of the rejections of all of the pending claims.

A. Note regarding Claim Construction

Applicant notes that the Examiner has the initial burden of proof in establishing *prima facie* anticipation or obviousness of a claimed invention under 35 U.S.C. § 102 or § 103. *In re Warner*, 379 F.3d 1011, 1016 (CCPA 1967). To make a fair review of the merits of a *prima facie* case of anticipation or obviousness, "[t]he Examiner must make specific findings as to claim construction." *Ex parte Beery*, Appeal No. 2008-0543, Application No. 09/954,823 (BPAI Sep. 29, 2008) (emphasis added); *Ex parte Blankenstein et al.*, Appeal No. 2007-2872, Application No. 10/116,312 (BPAI Aug. 26, 2008); and *see Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997); and MPEP §§ 706, 706.07. And as has been held by the Court of Appeals for the Federal Circuit, "[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." *Lindemann Maschinenfabrik v. American Hoist and Derrick Company*, 730 F.2d 1452, 1458 (Fed. Cir. 1984) (emphasis added); and *see Waldermar Link v. Osteonics Corp.*, 32 F.3d 556, 559 (Fed. Cir. 1994) (explaining that, during prosecution, "the patent Examiner acts as a fact-finder").

In the instant case, the Examiner has failed to provide Applicant with a sufficient claim construction or interpretation of the cited references so as to enable the Applicant to make a fair

review of the merits of the case of anticipation or obviousness proffered by the Examiner, or to effectively reply or readily judge the advisability of an appeal. Other than quoting or paraphrasing Applicant's claim language with annotated citations to figures, or column and line numbers of the cited references, the Examiner provides no finding or other explanation regarding Applicant's claims, the cited references, or the application of the cited references to Applicant's claims. The Board of Patent Appeals has found that the mere citing of passages of the prior art is insufficient to meet the Examiner's "initial burden of pointing out where the applied prior art teaches or suggests Appellant's invention." *Ex parte* Beery, Appeal No. 2008-0543, page 5. As stated by the Board in *Ex parte* Beery, "The difficulty we have with the Examiner's position is its failure to specifically point out where in the cited passages there is found a teaching of each of the disputed claim limitations." *Id.*

For at least the foregoing reasons, Applicant respectfully submits that the Examiner has failed to establish *prima facie* anticipation or obviousness of the claimed invention.

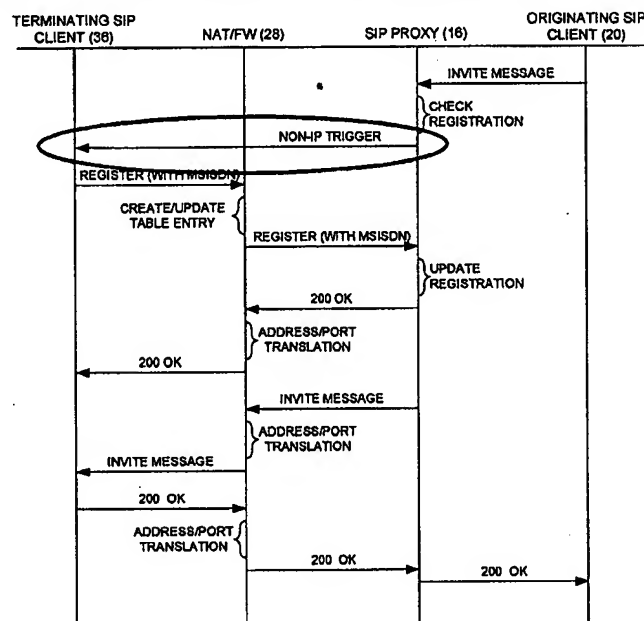
B. Claims 1-5, 7-14, 16-23, 25-32, 34-41, 43-50 and 52-54 are Patentable

The Official Action rejects Claims 1-5, 7-14, 16-23, 25-32, 34-41, 43-50 and 52-54 as being anticipated by Stanforth. Briefly, Stanforth discloses a gateway node and gateway controller of an ad hoc peer-to-peer mobile radio access system for interfacing that ad hoc system with a cellular network and/or public switched telephone network (PSTN). As disclosed, an ad hoc terminal registers with a particular gateway node and gateway to enable the ad hoc terminal to originate calls and other communication to the cellular network or PSTN via the ad hoc network, or terminate calls and other communication from the cellular network or PSTN via the ad hoc network.

1. Claims 1-9, 19-27 and 37-45 are Patentable over Stanforth

As explained during the telephone interview, according to a first aspect of the present invention, as reflected by independent Claim 1 and illustrated for example by FIG. 5 of the present application shown below (horizontally flipped and annotated for comparison purposes), an apparatus (e.g., proxy 16) is provided for establishing a communication session with a terminal (e.g., terminating SIP client 36). In contrast to this aspect of the present invention, Stanforth (or Dingman) does not teach or suggest an apparatus (or processor thereof) in a

network sending a network-independent trigger to a terminal in response to a connection request, and in response to the network-independent trigger, receiving a response via the network to thereby register the terminal with the apparatus and acquire a network-dependent identity of the terminal. Stanforth does disclose a gateway within an ad hoc network receiving a registration message from an ad hoc terminal to register the ad hoc terminal with the ad hoc network, or more particularly the gateway of the ad hoc network. Stanforth does not teach or suggest, however, that its gateway sends an ad-hoc-network-independent trigger to the terminal in



Pat Appl., FIG. 5 (flipped)

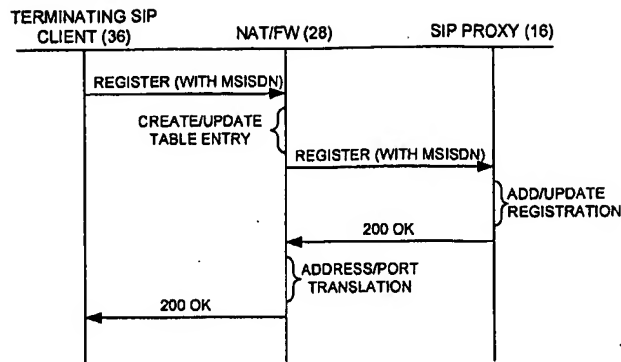
response to which the gateway receives its registration message, similar to the processor of independent Claim 1 sending a network-independent trigger, in response to which the processor receives a registration message from the terminal. Instead, Stanforth clearly discloses that its terminal initiates registration with the ad hoc network. See Stanforth, paragraph [0042], [0055]-[0057].

Applicant notes that the Official Action cites a terminal call origination process, or rather messages of that process, as corresponding to the connection request and network-independent trigger of independent Claim 1. That is, with reference to FIG. 6 of Stanforth, the Official Action cites a terminal-to-gateway setup dialogue as corresponding to the recited connection request, and cites a gateway-to-terminal alerting message as corresponding to the recited network-independent trigger. Applicant respectfully submits, however, that even if one

considered the terminal-to-gateway setup dialogue as a connection request, Stanforth does not teach or suggest its gateway (alleged processor) being configured to send the gateway-to-terminal alerting message (alleged network-independent trigger) in response to that dialogue (alleged connection request), similar to the processor of independent Claim 1. Moreover, Stanforth does not teach or suggest its gateway (alleged apparatus) being configured to receive a registration message from the terminal in response to the gateway-to-terminal alerting message (alleged network-independent trigger) to register the terminal with the gateway (alleged apparatus) and acquire a network-dependent identity of the terminal, similar to the processor of independent Claim 1.

2. *Claims 10-18, 28-36 and 46-54 are Patentable over Stanforth*

According to a second aspect of the present invention, as reflected by independent Claim 10 and illustrated for example by FIG. 4 of the present application shown below, an apparatus (e.g., proxy 16) is provided for establishing a communication session with a terminal (e.g., terminating SIP client 36). In contrast to this second aspect of the present invention (and, e.g., independent Claim 10 in particular), Stanforth (or Dingman) does not teach or suggest an apparatus (or processor thereof) in a network receiving a registration message from a terminal via a network, the registration message including a network-independent identity of the terminal so that the terminal may be sent a network-independent trigger in a manner similar to that recited by independent Claim 1. More particularly, Stanforth (or Dingman) does not teach or suggest an apparatus including a processor configured to receive, from a terminal via a network, a registration message including a network-independent identity of the terminal. Further, Stanforth (or Dingman) does not teach or suggest the processor being configured to send a network-independent trigger to the terminal based on the network-independent identity to thereby acquire a network-dependent identity of the terminal to thereby enable establishment of a communication session based upon the network-dependent identity of the terminal. Again, instead of disclosing its gateway triggering a terminal to update its registration with the gateway



Pat Appl., FIG. 4

(much less via a network-independent trigger), Stanforth clearly discloses that its terminal initiates registration with the ad hoc network. *See* Stanforth, paragraph [0042], [0055]-[0057].

Applicant therefore respectfully submits that independent Claim 1, and by dependency Claims 2-9, is patentably distinct from Stanforth. Applicant also respectfully submit that previously presented independent Claims 10, 19, 28, 37 and 46 recite subject matter similar to that of independent Claim 1, including the aforementioned triggering the terminal (or an apparatus) or identifying the terminal (or an apparatus) independent of the network for which a communication session may ultimately be established. As such, Applicant also respectfully submit that independent Claims 10, 19, 28, 37 and 46, and by dependency Claims 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Stanforth for at least the same reasons given above with respect to independent Claim 1.

C. Claims 6, 15, 24, 33, 42 and 51 are Patentable

The Official Action rejects Claims 6, 15, 24, 33, 42 and 51 as being unpatentable over Stanforth, in view of Dingman. As explained above, independent Claims 1, 10, 19, 28, 37 and 46, and by dependency Claims 2-9, 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from Stanforth. Applicant respectfully submits that Dingman does not cure the deficiencies of Stanforth, and there is no apparent reason for one skilled in the art still to modify Stanforth with the teachings of Dingman to disclose the claimed invention. Thus, for at least the foregoing reasons as well as those given above with respect to independent Claims 1, 10, 19, 28, 37 and 46, Claims 6, 15, 24, 33, 42 and 51 are also patentably distinct from Stanforth, in view of Dingman.